

Office Action Summary

Application No.

08/953,477

Applicant(s)

Kara et al.

Examiner

Jimmy Nguyen

Group Art Unit

2722



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-85 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-85 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2722

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1- 12, 14-18, 21-51 and 53-56** are rejected under 35 U.S.C. 103(a) as being unpatentable over Micali in view of Kuzma.

Regarding **claims 1, 27, and 32**, Micali discloses a method of transmitting a message using a trusted party, the method teaches: mean for selecting third location discrete from first location and second location, third location being associated with a party disinterested in transmitted document (refer to figure 1 item T); means at least in part operable at first location for transmitting a document and authentication information (refer to column 5 lines 62-67 and column 6 lines 1-7 and 53-56 note: other valuable information may refer as the authentication information) to third location (refer to figure 1 item A and 1); means at least in part operable at third location for receiving document and authentication information transmitted by transmitting means, wherein received document is in electronic form after receipt at third location (refer to figure 1 item 1 and T and column 6 lines 37-42) ; means operable at least in part at third location for identifying a sender of transmitted document through reference to authentication information (refer to column 6 lines 58-61 note: customization step is part of the valuable information); means

Art Unit: 2722

at least in part operable at third location for producing a confirmation of receipt of received electronic document (refer to figure 1 item 2-A); means at least in part operable at third location for reproducing for delivery to second location received electronic document in a plurality of different formats (refer to figure 1 item T and 2-B and column 4 lines 62-67 and column 5 lines 1-2). However, Micali does not disclose a substeps of verifying an indication of pre-payment for document transmission. Kuzma discloses a substeps of verifying an indication of pre-payment for document transmission (refer to figure 5 item 412 and the abstract), Kuzma also disclose an authentication information transmit by the transmitter means (refer to the abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the substeps taught by Kuzma into Micali's method. Such combination will provides the carrier to securely and accurately invoice a mailer for mail placed into an electronic postage system.

Regarding **claim 2 and 33**, Micali disclose a means for time stamping transmitted document according to a secure real time clock in communication with transmitting means (refer to column 6 lines 53-56);

Regarding **claims 3-5, 34-42, and 44-47**, Micali disclose a means for accepting documents transmitted in machine readable electronic form; received document is selected from the group consisting of a FAX transmission and an e-mail transmission; transmitting means is selected from the group consisting of general purpose computer operating under control of a general purpose electronic mail application; a general purpose computer operating in combination

Art Unit: 2722

with an intermediary communication server; a general purpose computer operating under control of a special purpose application adapted specifically for system; a facsimile transmission device; (refer to column 4 lines 59-65 and column 6 lines 35-40 and 57-60). However, Micali does not disclose a mean for accepting documents transmitted in humanly readable tangible form and a received document is selected from the group consisting of a printed document, because of its conventionality as evidenced by Hybrid Mail of Norway Post Service. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the method of Micali in view of well known prior art. Such combination will provide a convenience for the sender to transmit a message.

Regarding to **claims 6 and 51**, Micali discloses a transmitting means further comprises means for communicating additional information with transmitted document (refer to column 6 lines 53-55).

Regarding to **claims 7 and 28**, Kuzma discloses additional information comprises an indication of payment for the service of transmitting document (refer to column 2 lines 34-36); Regarding to **claims 8 and 48**, Kuzma discloses a confirmation producing means is inoperable until indication of payment is validated (refer to column 6 lines 13-17 and column 7 lines 32-35);

Regarding to **claims 9, 29-31, 49 and 50**, Kuzma discloses an indication of payment is an indicia of pre-payment deducted from a credit storage device coupled to transmitting means, indicia being transmitted to receiving means accompanying transmitted document and an

Art Unit: 2722

indication of payment is authorization to fund the transmission from an account established external to transmitting means (refer to column 7 lines 63-67 and column 8 lines 1-8);

Regarding **claim 10**, Kuzma disclose a credit storage devices includes an internal time device and transmitted document includes time information provided by internal time device (refer to column 3 lines 10-16);

Regarding **claims 12 and 53**, Micali disclose an additional information comprises instructions regarding the delivery of transmitted document to second location (refer to column 5 lines 65-67 and column 6 line 1);

Regarding **claim 14**, Micali disclose a means for formatting received document according to a predetermined protocol for delivery to second location (refer to column 6 lines 57-67 and column 7 lines 1-13);

Regarding **claims 15, 16, 55 and 56**, Micali disclose a means for reproducing received document as a physical document to be physically delivered to second location (refer to column 13 lines 19-23); a means for reproducing received document as a properly formatted electronic document to be electronically delivered to second location (refer to column 12 lines 5-34);

Regarding **claims 17 and 18**, Micali disclose a reproducing means comprises a document printer operating under control of disinterested party; a document printer is disposed at a location other than second location and wherein delivery of transmitted document includes physical handling of reproduced document by disinterested party; (refer to column 13 lines 19-21);

Art Unit: 2722

Regarding **claims 19 and 20**, Kuzma disclose a reproducing means further comprises means for reproducing an indicia of authorization to deliver transmitted document to second location by disinterested party and indicia comprises a postage meter stamp (refer to column 3 lines 17-44);

Refer to **claims 21 and 54**, Micali disclose a receiving means further comprises means for determining an address of second location from information transmitted by transmitting means (refer to 13 lines 19-22 note: the Post Office must know the address of second location to deliver a print z);

Regarding **claims 22, 24, 25 and 43**, Micali disclose a reproducing means further comprises means for preparing a delivery container suitable for use in delivering transmitted document, prepared delivery container including determined address; a reproducing means comprises means for determining a particular method of delivery of received document to second location; means for reproducing received document according to determination made by determining means; and determining means comprises a database of preferred delivery methods (refer to column 13 lines 19-22 and 36-37 note: Micali must have a database of preferred delivery methods such as by traditional certified mail delivery to B with document print on paper or store in a computer diskette and by electronic mail.);

Regarding **claim 23**, Micali and Kuzma does not specifically disclose a document printer is disposed at second location, because of it conventionality. Examiner take Official Notice that it

Art Unit: 2722

is common in the art to have a document printer within any computer system such one located at second location or B location in Micali case.

Regarding **claim 26**, Micali and Kuzma does not specifically disclose a means operable at least in part at third location for sorting a plurality of transmitted documents, including transmitted document according to a criteria selected from the group consisting of a delivery route, a recipient, a class of delivery and a sender, because of it conventionality. Examiner take Official Notice that it is common in the art for every Post Office or third location to have a sorting capability according to deliver route, a recipient, a class of delivery and a sender.

3. **Claims 19 and 20** rejected under 35 U.S.C. 103(a) as being unpatentable over Micali and Kuzma as applied to **claims 1, 17 and 18** above, and further in view of Talmadge.

Regarding **claims 19 and 20**, Micali and Kuzma discloses all of the limitation except: a reproducing means further comprises means for reproducing an indicia of authorization to deliver transmitted document to second location by disinterested party and indicia comprises a postage meter stamp. Talmadge discloses a reproducing means further comprises means for reproducing an indicia of authorization to deliver transmitted document to second location by disinterested party and indicia comprises a postage meter stamp (refer to column 3 lines 45-64 and figure 1 item 17 and 18). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine Talmadge into Micali and Kuzma's method. Such combination will provide a less expensive and higher convenience for the sender to transmit a message.

Art Unit: 2722

4. **Claims 57-74** are rejected under 35 U.S.C. 103(a) as being unpatentable over Micali, Kuzma and Talmadge as applied to **claims 1- 12, 14-51 and 53-56** above, and further in view of well known prior art.

Regarding **claims 57-74**, Micali, Kuzma and Talmadge discloses all of the limitation except: receiving means comprises means for electronically receiving transmitted information including means for converting transmission to electronic form if transmitted information is not initially in electronic form, because of its conventionality. It's well known in the art is that a facsimile system can be placed at receiving location to converting a document in human readable form to electronic form. Such system can be evidently show by Patel et al.(refer to page 66 right column). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to place the facsimile system at the receiving location or Post Office in Micali system and to have it convert a document in human readable form to electronic form. Such placement could provide a convince for the sender to transmit a message.

5. **Claims 13, 52 and 75-85** are rejected under 35 U.S.C. 103(a) as being unpatentable over Micali and Kuzma as applied to **claims 1- 12, 14-51 and 53-56** above, and further in view of Hoffman et al.

Regarding **claims 13, 52 and 75-85**, Micali and Kuzma discloses all of the limitation except: an additional information comprises instructions regarding storage of a copy of transmitted document by receiving means. Hoffman et al. disclose an additional information comprises instructions regarding storage of a copy of transmitted document by receiving means

Art Unit: 2722

(refer to column 34 lines 5-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine Hoffman et al. into Micali and Kuzma's method. Such combination would provide a convince for the sender to retrieve the prior message.

6. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Vazana (5,850,519) disclose a computerized mail notification system and method which detects calls from a mail server.

Cordery et al. (5,796,841) disclose a secure user certification for electronic commerce employing value metering system.

Cordery et al. (5,781,634) disclose an electronic data interchange postage evidencing system.

Dahlen (5,870,454) disclose telecommunications speech/text conversion and message delivery system.

Hunter (5,377,268) disclose metering system with remotely resettable time lockout.

Bashoura et al. (5,862,202) disclose a fax routing system and method using standard fax machine and personal computer.


Kaufeld et al. (5,859,967) disclose a method and system for relaying communication from authorized users.

Art Unit: 2722

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Nguyen whose telephone number is (703) 305-2725. The examiner can normally be reached on M-F from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5397.


EDWARD L. COLES
SUPERVISORY PATENT EXAMINER
GROUP 2700



JIMMY NGUYEN